

Remarks/Arguments:

Claims 1-52 were pending at the time of the office action. The office action states that claims 8-13, 21, 23, 24, 27-30 and 32-52 are withdrawn from consideration, according to the applicants' November 7, 2005 response. The applicants believe that claims 13 and 27 were improperly included in this listing. Claim 13 reads on a metal surface having any of the shapes recited (fiber, coil, sphere, etc.), and claim 27 recites an oxide (silica) and encompasses chemical functional groups (other than amino). Accordingly, the applicants believe that the correct listing of withdrawn claims should be 8-12, 21, 23, 24, 28-30, and 32-52, and the accompanying list of claims reflects this understanding.

Rejections under 35 U.S.C. § 102

Claims 1-7, 14-20, 22, 25-26, and 31 are rejected under 35 U.S.C. § 102(e) as anticipated by US 2004/0115416 ('416). The applicants traverse this rejection, because '416 is not a valid reference under § 102(e). That subsection states that the reference must be:

...(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language...

The application leading to the '416 published application was filed on October 9, 2003, later than the filing date of either the 60/411,871 provisional application (September 20, 2002) or the 10/427,242 nonprovisional application (May 1, 2003) from which the present application derives priority. Thus it is not a § 102(e) reference. The applicants also note that the published PCT application from which '416 derives priority was published in German, not English, and therefore is also not effective under § 102(e). The applicants therefore respectfully request withdrawal of the rejection.

Claims 1-6, 14-20, 22, 25 and 31 are rejected under 35 U.S.C. § 102(b) as anticipated by US 5,814,550 ('550). Claim 1 has been amended to incorporate the alternative limitations of claims 2 and 3 as filed, namely that the device is an implantable device or a drug delivery device, and to recite that the functional layer is adherent to the surface as supported in the published application at [0106]. The applicants submit that this amendment obviates the rejection, and point out that '550 does not teach the claim feature of an implantable device or a drug delivery device. In regard to claims 2 and 3, the office action states that such a limitation is a future intended use and therefore is not given patentable weight. The applicants respectfully disagree, and note that recitation of an implantable device or a drug delivery device is a structural limitation. Structures for such devices are well known in the art, and include for example orthopedic implants, as discussed in paragraph [0004] of the published application. Other implantable devices include sutures and surgical meshes, as discussed in paragraph [0059]. Still further devices are described in paragraph [0123], and include ceramic or metal implants for use in semiconductor devices that serve as a biosensor or chemical sensor, such as a Chemically Sensitive Field-Effect Transistor (ChemFET) or a microcantilever sensor. Illustrative sensors of this sort include ChemFET arrays, microcantilever sensors, and photodetectors and photodiodes, i.e., devices that perform optical measurements in vivo. All of

these devices are known in the art as implantable. Such implantable structures are clearly differentiated from non-implantable ones, such as the surfaces adapted for cell culture for use in forming Petri dishes, coverslips, slides, plates, flasks, cell cubes, etc. as taught by the '550 reference. (See column 4 lines 8-11) Unlike the present invention, the '550 reference does not teach implantable structures, and therefore does not anticipate any of the instant claims. Accordingly, the rejection of claim 1 and its dependents should be withdrawn.

Claims 1-5, 14-19, 25-26 and 31 are rejected under 35 U.S.C. § 102(b) as anticipated by US 6,086,863 ('863). In that reference, functionalized polymeric microspheres in a pharmaceutically acceptable carrier are applied to wounds to accelerate healing. Bandages may be soaked with such compositions, and the office action construes this as disclosing particles that are "associated with" the bandage. Claim 1 has been amended to more distinctly point out that the layer comprising the functionalized particles is adherent to the underlying surface, a feature that '863 does not teach. In fact, adhesion of the particles of '863 to a bandage would render the resulting structure unfit for its intended purpose.

Preferably, the second step includes applying an occlusive or non-occlusive bandage, or other suitable covering soaked in the liquid suspension containing the microspheres, to the wound. This substantially reduces or eliminates absorption of the microspheres by the bandage or covering. ('863 column 20, lines 60-65, emphasis added)

Thus the present claims are not anticipated by '863, because there is no teaching that there is adherence between the particles and the bandage, and, as the above statement makes clear, there would be no motivation to provide such adhesion because it is taught against by the '863 disclosure. Further, there is no teaching or suggestion in '863 to provide an implantable device, as recited in amended claim 1, and thus the '863 reference is deficient as either a § 102 or § 103 reference in this respect as well. For all of these reasons, the rejection should be withdrawn.

Other Amendments

Paragraph [0078] of the published application and claim 26 are amended to replace the term "methylacrylate" with "methacrylate." This is a typographical correction. New dependent claims 53 and 54 recite specific implantable structures, as supported at the passages cited in the foregoing remarks. Several other claims are also amended to conform them to preferred USPTO format. None of these amendments introduces new matter.

Conclusion

For all of the foregoing reasons, the Applicants submit that the pending claims are now in condition for allowance, and respectfully request early notification of same. The Applicants invite the Examiner to contact their undersigned representative, Frank Tise, if it appears that such contact may expedite examination of this application.

Respectfully submitted,

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RCHP-124US

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